



**EDDIE T. DIONISIO,**  
Petitioner,

**-versus-**

**LA TULSIANI,**  
Respondent-Registrant.

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**IPC No. 12-2011-00282**  
Petition for Cancellation of:  
UM Reg. No. 2-2009-000166  
Date Issued: 28 December 2010  
**Title: "MULTI-PURPOSE  
FOLDABLE LADDER"**

X-----X

**NOTICE OF DECISION**

**ABRENICA ARDIENTE ABRENICA AND PARTNERS**

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Diliman, Quezon City

**GREETINGS:**

Please be informed that Decision No. 2015 - 61 dated April 24, 2015 (copy enclosed) was promulgated in the above entitled case.

Taguig City, April 24, 2015.

For the Director:

  
**Atty. EDWIN DANILO A. DATING**  
Director III  
Bureau of Legal Affairs



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Decision No. 2015- 61

### DECISION

Eddie T. Dionisio<sup>1</sup> ("Petitioner") filed an opposition to Utility Model ("UM") Registration No. 2-2009-000166. The contested registration, issued to La Tulsiani<sup>2</sup> ("Respondent-Registrant"), covers "MULTI-PURPOSE FOLDABLE LADDER."

The Petitioner maintains that the contested utility model does not meet the requirements of registrability, particularly on novelty, and on the ground that the Respondent-Patentee is not the owner thereof. It contends that its UM Registration No. 2-2008-000427 for "FOLDABLE LADDER", which was previously registered, has the same construction as that of UM Registration 2-2009-000166 and that the former affects the registrability of Respondent-Registrant's utility model being a novelty-negating prior art therefor. It alleges that the Respondent-Registrant is completely in bad faith when the contested utility model was applied for registration on 20 April 2009 after the latter received a demand letter from Abrenica Ardiente Abrenica and Partners dated 06 March 2009.

In support of the allegations in the instant Petition, the Petitioner submitted the following as evidence:<sup>3</sup>

1. certified copy of UM Registration No. 2-2008-000427;
2. copy of the demand letter to Visita International Phils. Inc. dated 06 March 2009;
3. copy of UM Registration No. 2-2008-000166;
4. judicial affidavit of Engr. Rolando B. Saquilabon; and
5. affidavit of Eddie T. Dionisio.

For its part, the Respondent-Registrant asserts that the instant case is related to Visita International Phils. Inc. vs. Eddie T. Dionisio and Ultimate Exim Trading & Development Co. docketed as 12-2008-00133. It claims that the case must be

<sup>1</sup> A global pharmaceutical corporation, duly organized and existing under and by virtue of the laws of Switzerland with business address at CH-4002 Basel, Switzerland.

<sup>2</sup> With address at Devashish, Alkem House, Senapati Bapat Marg, Lower Parel Mumbai India.

<sup>3</sup> Marked as Exhibits "A" to "E", inclusive.

**Republic of the Philippines  
INTELLECTUAL PROPERTY OFFICE**

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dismissed on the ground of forum shopping. It further alleges that the Petitioner cannot claim protection on the "First to file" rule or claim invention or novelty because of the prior existence of two US patents and the latter's true personality as mere importer of the foldable ladder.

The Mediator's Report shows that the parties refused to undergo mediation proceedings. Thus, the Hearing Officer conducted a preliminary conference on 03 April 2013. Upon termination, the parties were directed to submit their respective position papers within ten days therefrom. After which, the case is deemed submitted for resolution.

The issue is whether the Respondent-Registrant's registration for "MULTI-PURPOSE FOLDABLE LADDER" should be cancelled.

Section 61 of R.A. No. 8293, also known as the Intellectual Property Code of the Philippines ("IP Code"), provides that:

***"Section 61. Cancellation of Patents. - 61.1. Any interested person may, upon payment of the required fee, petition to cancel the patent or any claim thereof, or parts of the claim, on any of the following grounds:***

- (a) That what is claimed as the invention is not new or Patentable;***
- (b) That the patent does not disclose the invention in a manner sufficiently clear and complete for it to be carried out by any person skilled in the art; or***
- (c) That the patent is contrary to public order or morality."***

Corollarily, Rule 213 of the Rules and Regulations on Utility Models and Industrial Designs ("Rules") provides:

***"Rule 213. Cancellation of the utility model registration. The utility model registration shall be cancelled on the following grounds:***

- (a) That the utility model does not qualify for registration as a utility model and does not meet the requirements of novelty and industrial applicability or it is among non-registrable utility models;***
- (b) That the description and the claims do not comply with the prescribed requirements;***
- (c) That any drawing which is necessary for the understanding of the utility model has not been furnished;***
- (d) That the owner of the utility model registration is not the maker or his successor in title."***

While novelty is an indispensable requirement in the registration of a utility model, Section 109.2 of the IP Code expressly states that the provision on substantive examination for invention patents found in Section 48 of the IP Code is not applicable to utility model applications. Thus, Rule 205 of the Rules provide:

**"Rule 205. Registration of utility model. A utility model application shall be registered without substantive examination provided all fees such as filing, excess claims and publication fees are paid on time and all formal requirements set forth in these Regulations are filed. Furthermore, in order to help the applicant consider his options under the IP Code and these Regulations, the application shall likewise be classified and a search conducted to determine prior art."**

After a judicious evaluation, this Bureau finds merit in the instant Petition.

The contested utility model is for a "MULTI-PURPOSE FOLDABLE LADDER" consisting of the following claim: "Claim 1: A multi-purpose foldable ladder comprising a plurality of ladder members each being defines by a pair of parallel posts being bridged by transverse bars along the length thereof, each of the ladder members capable of being joined. Folded, bended and locked in a desired manner by conventional self-locking hinges, characterized in that the opposing endmost ladder members each being provided by laterally extending stabilizing rods having slip resistant caps inserted thereon.

The drawings of the questioned UM Registration No. 2-2009-000166, which was issued on 28 December 2010, consists of the following:

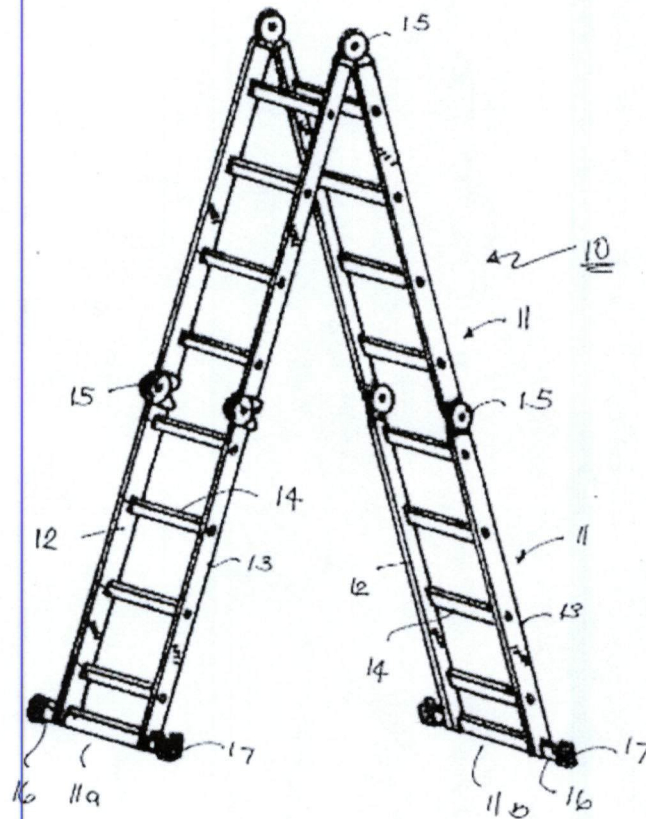


FIG. 1

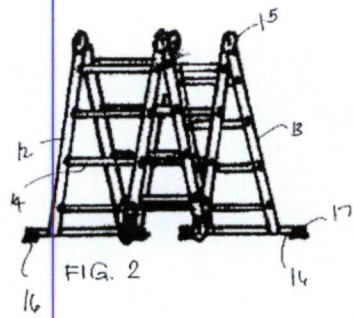


FIG. 2

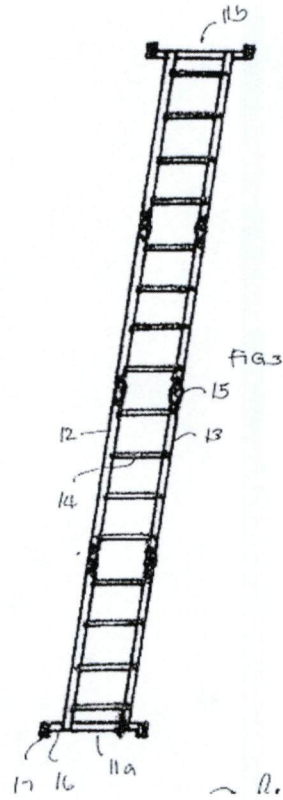


FIG. 3

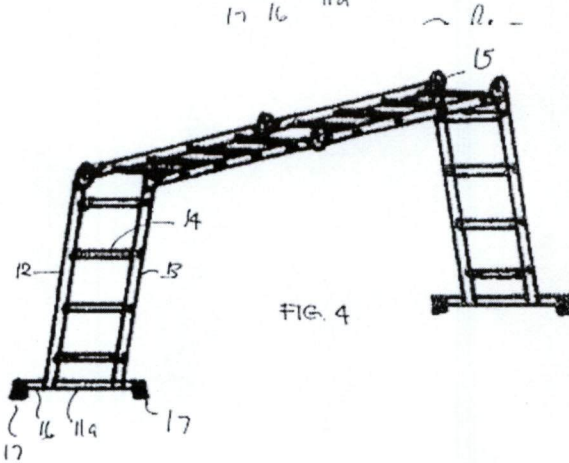


FIG. 4

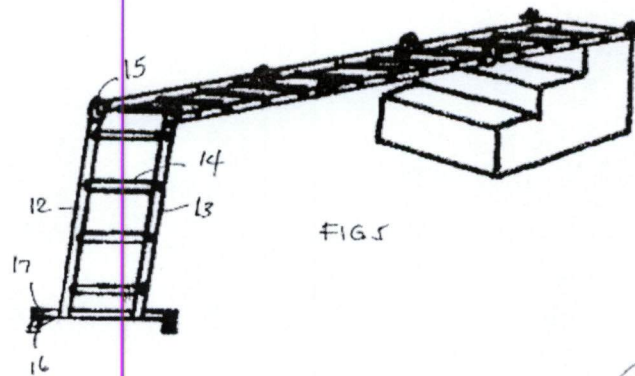


FIG. 5

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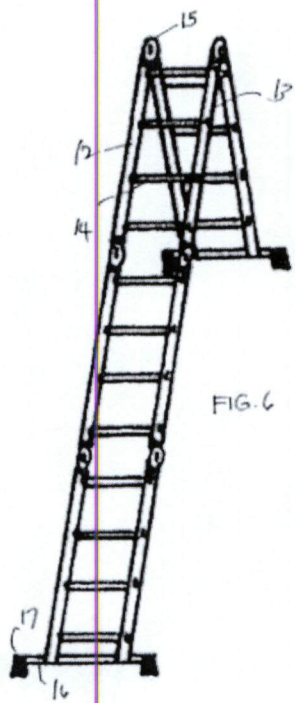


FIG. 6

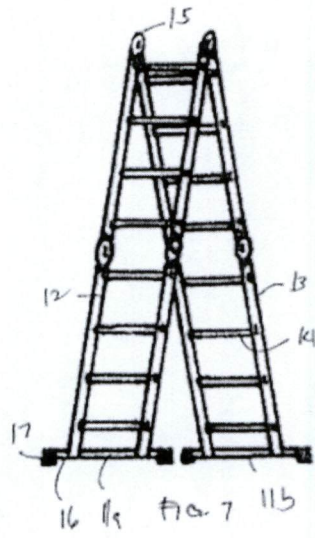


FIG. 7

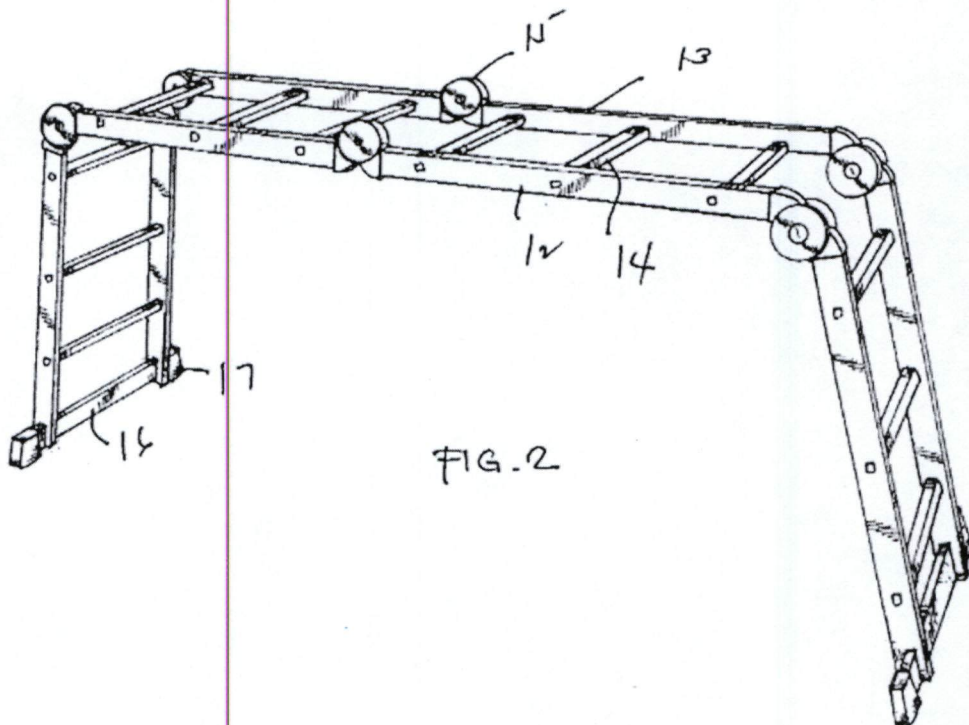
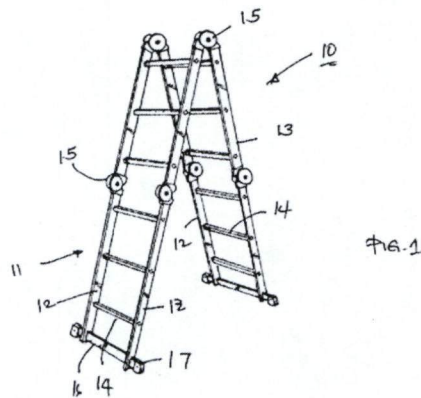
  
LAL TULSIANI

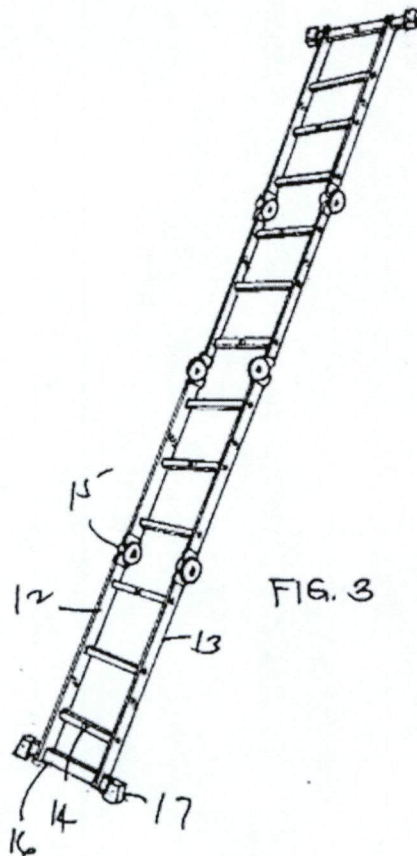


FIG. 8

Records show that the Petitioner has earlier applied for UM Registration No. 2-2008-000427 for "FOLDABLE LADDER", which was allowed registration on 20 October 2008 with the following claim: "A foldable ladder comprising a plurality of sections each being defined by a pair of spaced longitudinal poles each being bridged by transverse bars, and sections being spaced connected end to end by lockable hinges, and transverse footings with anti-slip pads at both ends thereof are provided at the ends of two endmost sections.

The drawings of the "FOLDABLE LADDER" consists of the following figures:





Clearly, as depicted in the drawings, the Respondent-Registrant's registration contains all the characteristics of that of the Petitioner's. Both comprise of a plurality of sections or ladders, each being defined by longitudinal posts (12 and 13) and transverse bars (14). Each section is interconnected by means of a lockable hinge (15) to allow the sections to be foldable and adjustable with respect to each other. Furthermore, the substantially similar arrangement and interconnection of all the essential elements of the ladders, the Petitioner's and the Respondent-Registrant's ladders to be adjusted and folded in the same manner resulting to the shapes shown in the drawings of the two utility models.

Therefore, UM Registration No. 2-2008-000427 consists a prior art of UM Registration No. 2-2009-000166. Succinctly, in the case of **Angelita Manzano vs. Court of Appeals**, the Supreme Court held that:<sup>4</sup>

*"The element of novelty is an essential requisite of the patentability of an invention or discovery. If a device or process has been known or used by others prior to its invention or discovery by the applicant, an application for a patent therefor should be denied; and if the application has been granted, the court, in a judicial proceeding in which the validity of the patent is drawn in question, will hold it void and ineffective. It has been*

<sup>4</sup> G.R. No. 113338, 05 September 1997.



***repeatedly held that an invention must possess the essential elements of novelty, originality and precedence, and for the patentee to be entitled to the protection the invention must be new to the world."***

Anent the Respondent-Registrant's contention that the case must be dismissed on the ground of forum shopping, the same holds no water. The elements of forum-shopping are: (a) identity of parties or at least such parties that represent the same interests in both actions; (b) identity of rights asserted and reliefs prayed for, the relief being founded on the same facts; (c) identity of the two preceding particulars, such that any judgment rendered in the other action will, regardless of which party is successful, amount to res judicata in the action under consideration.<sup>5</sup> There is no forum shopping as the issue in this case is whether UM Registration No. 2-2009-000166 should be cancelled. In IPC Case No. 12-2009-00133, on the other hand, the issue is whether Petitioner's UM Registration No. 2-2008-000427 should be cancelled. The subject matters and issues are different such that the decision in one cannot affect the other.

In view thereof, the Decision No. 2013-92 (IPC Case No. 12-2009-00133) promulgated on 28 May 2013 does not affect the instant case. In the said case, this Bureau ordered the cancellation of the Petitioner's mark on the ground that the same consists a prior art of US Patent No. 4,842,089. The said decision, however, is still pending appeal. Thus, there is no merit in Respondent-Registrant's assertion that the Petitioner lost its standing to assert its superiority. More importantly, even should the said findings be sustained, the Respondent-Registrant's utility model registration should still be ordered cancelled as it likewise forms a prior art of US Patent Nos. 4,842,089, consisting of the following figures:

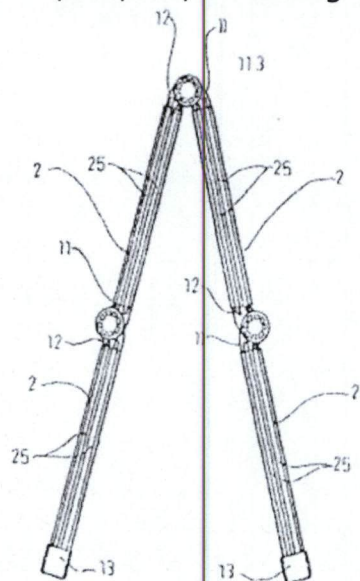


Figure 16

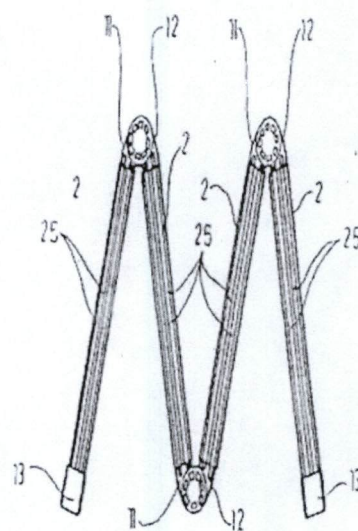


Figure 15

<sup>5</sup> Pentacapital Investment Corporation vs. Makilito Mahinay, G.R. No. 171736, 05 July 2010.

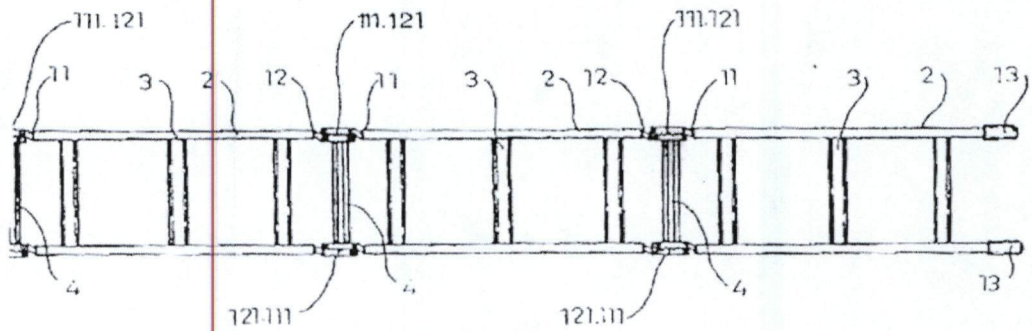



Figure 17

The aforesaid US Patent and the subject utility model both consists of foldable sections, a prior of spaced apart uprights longitudinal poles and plurality of rungs transverse bars. Should the Petitioner's registration be cancelled on the ground that it consists a prior art of US Patent No. 4,842,089, the same conclusion can be drawn with respect to Respondent-Registrant's registration.

**WHEREFORE**, premises considered, the instant petition for cancellation is hereby **GRANTED**. Let the filewrapper of Utility Model Registration No. 2-2009-000166 be returned, together with a copy of this Decision, to the Bureau of Patents for information and appropriate action.

**SO ORDERED.**

Taguig City, 24 April 2015.

  
**ATTY. NATHANIEL S. AREVALO**  
 Director IV  
 Bureau of Legal Affairs